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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,398	12/05/2003	William M. Brandt	14012-071001/70-03-007	8841
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FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER GERGISO, TECHANE	
			ART UNIT 2137	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,398

Applicant(s)

BRANDT, WILLIAM M.

Examiner

TECHANE J. GERGISO

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/14/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a Final Office Action in response to the applicant's communication filed on February 14, 2008.
2. Claims 1-20 have been examined are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the claims are identified as "System", the components of the "system" are **instructions** executed by a computer and are thus considered programs per se Use of the word "**system**" does not inherently mean that the claim is directed to a **machine**. Only if at least one of the claimed elements of the system is **a physical part of a device** can the system as claimed constitute part of a device or a combination of devices to be a **machine** within the meaning of 101. They are, at best, a functional descriptive material per se Therefore, claims 10-18 are rejected as a system of **Software per se**, failing to fall within a statutory category of invention. *See MPEP 2106 (IV)(B)(1) Functional descriptive Matter.*

Response to Arguments

5. Applicant's arguments filed on February 14, 2008 have been fully considered but they are not persuasive.

Regarding claims 10-18 rejection under 35 USC 101, the applicant argues that because the claimed instructions are stored on a computer-readable medium, the fact that the instructions are stored makes the instructions a system and the stored instructions are a statutory subject matter. The examiner disagrees with the applicant's argument because the claims call for a system and just a stored instruction only by itself does not make the claims a system. In the claims, all elements of the claimed features are stored instructions. Only if at least one of the claimed elements of the system is **a physical part of a device** can the system as claimed constitute part of a device or a combination of devices to be a **machine** within the meaning of 101. Therefore, the applicant's argument is not persuasive to overcome the 101 rejections of claims 10-18.

Regarding claims 1-20 rejection under 35 USC 102, the applicant argues that:

“the Engberg reference fails to teach sequencing an encryption key transaction from a trusted service for generating for an individual a consumer identifier by issuing from a trusted service a primary key to the individual, issuing to the individual a unique identifier from said trusted service, and permitting the individual to generate and maintain a consumer-defined sequence through said trusted service. Instead, cited portions of the Engberg reference teach **not using a trusted service to generate a**

consumer identifier. In addition, the cited portions of the Engberg reference teach use of a SYMKEY that is generated using the public key of the company **rather than generating a consumer identifier by issuing a primary key and a unique identifier from the trusted service** and by allowing an individual to generate a consumer-defined sequence through the trusted service. Accordingly, since the Engberg reference fails to teach all “

The examiner disagrees with the applicant's analysis because the features alleged by the applicant is disclosed by Engberg as follows: [0400] Trusted party TP (Trusted service) **creates key pair** (Cl.Vir.Pu, Cl.Vir.Pr). The **Public Key is forwarded to and signed by CLIENT** and the signature is returned to TP (which discloses the trusted service issues as primary key to the individual client). [0401] Secret key of VID (Cl.Vir.Pr) is known only to TP, as **TP is backing the authenticity of VID to CLIENT** (issued virtual identifies to client). Therefore despite the applicant's argument, consumer identifier is generated using trusted services by issuing a key and identifier from trusted service. For these reasons, the applicant's argument is not persuasive to overcome the prior arts in record to place independent claims 1, 10 and 19 in condition for allowance. Dependant claims 2-9, 12-18 and 20 are also not placed in condition for allowance based on their dependency from their corresponding independent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Engberg (US Pub No.: 2003/0158960 A1).

As per claim 1:

Engberg discloses a method for preventing identity theft in electronic communications, comprising the steps of:

sequencing an encryption key transaction from a trusted service for generating for an individual a consumer identifier by performing the steps of:

(0228-0229; Master key, Client keys, temporary keys; [0260] A Virtual Identity is a pseudonym for an individual created for a specific purpose. Using the Trusted Party (TP), an individual can assume use a VID to communicate, trade etc. anonymously and under full control of the process. [0265] TP--Trusted Party--is generally treated as one entity identified by a TP Token Identifier or the public key of TP (TP.Pu) that can be verified in official registers such as X500 or X509. [0366] Establish a CLIENTKey which is a general symmetric encryption key between TP and CLIENT. [0401] Secret key of VID (Cl.Vir.Pr) is known only to TP, as TP is backing the authenticity of VID to CLIENT. [0400]-[0401]).

issuing to the individual a unique identifier from said trusted service; and

([0391] Establish VID (CLIENT/COMPANY). [0395] CLIENT establishes an anonymous identity towards a relation under full CLIENT control. [0401] Secret key of VID (Cl.Vir.Pr) is known only to TP, as TP is backing the authenticity of VID to CLIENT.)

permitting the individual to generate and maintain a consumer-defined sequence through said trusted service; and

([0404] This invention works with a secret shared symmetric key SYMKEY to encrypt communication between CLIENT and COMPANY. In the following the SYMKEY is treated as if it is reused from session to session; however the SYMKEY can just as well be generated as part of establishing a session as a session specific encryption key which is saved together with communication encrypted by the public key of CLIENT (Cl.Pu).

[0405] SYMKEY can be created without revealing this to TP.)

allowing the individual to control access to commercially related use of said consumer identifier by third parties .

([0475] When creating a virtual identity on behalf of CLIENT, TP creates a new set of signature keys (Cl.Vir.Pr and Cl.Vir.Pu). TP keeps the private key Cl.Vir.Pr which is not revealed to anyone else.)

As per claim 2:

Engberg discloses a method, comprising the steps of verifying commercially related use of said consumer identifier, comprising the steps of:

initiating a verification process from a requesting business entity via a secure connection
(0737; 0743);

comparing said consumer identifier with a pre-determined set of database records using said consumer-defined sequence in response to initiating said verification process (0489);

presenting a positive or negative confirmation to said requesting business, said business having registered with said trusted service (0491); and

confirming requested information relating to the individual via said secure connection, said requested information have been pre-authorized for presenting to said requesting business entity by the individual (0490).

As per claims 3 and 12:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of reporting to the individual the number of times at least one requesting business entity has initiated a verification process (0949-0952).

As per claim 4:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of confirming requested information relating to the individual including the individual's name, address, and photograph (90279; 0341-0342).

As per claim 5:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of confirming requested information relating to the individual including the individual's fingerprints (0338-0039; 0453).

As per claim 6:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the steps of storing said consumer identifier on a remote business database system and permitting the individual to modify said consumer identifier through a secure connection to a remote location (0694-0696).

As per claim 7:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of issuing to the individual a unique identifier from said trusted service according to a pre-determined set of business rules associated with a remote business database system (0270).

As per claim 8:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of allowing the individual to control commercial transactions using said consumer identifier (0552-0556).

As per claim 9:

Engberg discloses a method and instructions stored on a computer-readable medium, comprising the step of issuing to the individual a unique identifier from said trusted service, said unique identifier conveying in encrypted information relating to the individual's age and locale (0881; 0888).

Claims 10 and 11 are a system comprising instruction stored on a computer-readable medium for performing the steps of claims 1 and 2 respectively. Claims 10 and 11 are substantially similar to their corresponding method claims 1 and 2; and therefore, they are rejected with the same rationale given to reject claims 1 and 2 respectively.

Claims 19 and 20 are a computer readable storage medium comprising instruction stored on a computer-readable medium for performing the steps of claims 1 and 2 respectively. Claims 19 and 20 are substantially similar to their corresponding method claims 1 and 2; and therefore, they are rejected with the same rationale given to reject claims 1 and 2 respectively.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is ~~(571) 273-3784~~. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T.G./

May 8, 2008

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2137